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03 JAN 2007

In re Application of :
HEALD *et al* :
U.S. Application No.: 10/550,945 :
PCT No.: PCT/GB04/01394 :
Int. Filing Date: 29 March 2004 :
Priority Date: 28 March 2003 :
Attorney Docket No.: 0546-1082 :
For: PREPARATION OF VANILLIN FROM :
MICROBIAL TRANSFORMATION :
MEDIA BY EXTRACTION BY MEANS :
SUPERCRITICAL FLUIDS OR GASES :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 30 November 2006.

BACKGROUND

On 31 July 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 30 November 2006, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by two of the three named inventors; a two-month extension and fee; the petition fee; an affidavit by Ms. Lorette Saint-Cricq ('Decl. '); and other assorted documentary evidence with English translations (if required).

DISCUSSION

Applicants claim that three joint inventors (Steve Heald, Steve Myers and Tim Walford) refuse to cooperate in the above-identified application and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 31 July 2006.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the

nonsigning joint inventors.

Concerning item (1), the petition fee of \$200.00 has been paid.

With regards to item (3), the last known address of co-inventor Steve Heald, and is listed as:

19 Harcourt Drive
Canterbury CT2 8DP
United Kingdom

The last known address of co-inventor Steve Myers is listed as:

18 Christchurch
Ashford, Kent TN237XB
United Kingdom

The last known address of co-inventor Tim Walford is listed as:

35 Parkway
Dorking Surrey
United Kingdom

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the five co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Regarding item (2), the 37 CFR 1.47(a) applicants claim that three inventors refuse to cooperate. Petitioners burden in showing that an inventor refuses to cooperate is listed in section 409.03(d) of the MPEP which states, in part:

A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . .

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In this case, petitioners have submitted an affidavit by Ms. Lorette Saint-Cricq who states that she sent a copy of the subject patent application and a declaration to the three nonsigning inventors on 16 June 2006. Copies of the cover letters dated 16 June 2006 were enclosed along with postal receipt information. Ms. Saint-Cricq declares that she received a telephone call from Mr. Myers, who was with Mr. Heald at the time, requesting information on the documents. Ms. Saint-Cricq said that she has not received a response from either of these two inventors and states that "I understand that they do not want to sign."

This evidence is sufficient to constitute a refusal by both Mr. Myers and Mr. Heald. The telephone call verifies that they received and understood the contents of the documents. The fact that a response has not yet been received is considered conduct that constitutes a refusal to cooperate.

With regards to Mr. Walford, after receiving no word from the inventor, petitioners contacted the French Post Office to verify whether the documents mailed 16 June 2006 were received by him. The post office responded on 19 October 2006 stating in a letter that the "mail was distributed on June 21, 2006." A copy of this letter with an English translation was provided.

However, this evidence is not sufficient to meet item (2) of 37 CFR 1.47(a). Mr. Walford's conduct may constitute a refusal to cooperate; however, there is no proof that he received the documents in question.

The letter from the French Post Office signed by Ms. Trieste states only that the mail was delivered to the address listed. There is no receipt signature or statement that it was delivered in person to Mr. Walford. Mr. Walford may not even live at the address in question from the evidence presented. The 37 CFR 1.47(a) applicants should attempt to contact Mr. Walford by telephone, or mail to verify that the patent

documents were received, and if possible determine his intention to sign them.

For this reason, item (2) is not satisfied for Mr. Walford.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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